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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,509

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Christopher Russell Byrne

1984

60333

7590

05/24/2007

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EXAMINER

THOMASSON, MEAGAN J

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No. .

10/688,509

Applicant(s)

BYRNE, CHRISTOPHER  
RUSSELL

Examiner

Meagan Thomasson

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 70 and 72 is/are allowed.
- 6) ☒ Claim(s) 26-33, 36, 37, 39-67 and 71 is/are rejected.
- 7) ☒ Claim(s) 34, 35, 68 and 69 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

The examiner acknowledges the amendments made to claims 40,46,48,49,52-54,57,59,63-65 and 67.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 40-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 40 recites the limitation "the secondary game award amount being equal to the product of a **game award amount** multiplied by a multiplier value". This is not disclosed in the specification. The specification describes:

secondary game award amount = (the number of shares purchased by a player) x (value of a single share)

value of a single share = (jackpot total) / (number of participants in the secondary game)

Thus, the progressive jackpot total, i.e. the game award amount, is divided by the number of entrants in the secondary game prior to being multiplied by the value of a share. That is:

Secondary game award amount = (jackpot total / number of participants) x (number of shares purchased by a player)

The claim language recites:

Secondary game award amount = (jackpot total) x (number of shares purchased by a player)

This is not disclosed in the specification. Claims 48,54,57,59,63-65 recite similar limitations. Please see previous rejection for citation of specification passages describing the secondary game award amount.

Claim 42 recites the limitation "wherein the central processing unit is programmed to select the indicia of an entry of an entrant". This is not disclosed in the specification as originally filed, as applicant's specification only discloses allowing a player to select the indicia of an entry (P. 1, paragraph 4).

Claims 44 and 45 recite limitations drawn to a "remote receiver operatively coupled to the central processing unit". This is not disclosed in the applicant's specification as originally filed.

Claims 47,58,62 recite the limitation "the central processing unit is programmed to determine the secondary game outcome for the secondary game ... before determining the primary game outcome for the primary game". This is not disclosed in the applicant's specification as originally filed.

Claim 48 recites a method of conducting a group participation wagering game in combination with an individual participation wagering game, the method comprising

Art Unit: 3714

“receiving entries from a plurality of entrants... determining whether a winning outcome is achieved ... allocating a multiplier value, the multiplier value being allocated from a plurality of multiplier values capable of being applied to the individual prize amount for each entrant”. This is not enabled in the applicant’s specification as originally filed, as the step of “allocating a multiplier value” is done prior to determining whether a winning outcome is achieved. That is, the number of shares purchased by a player acts at the multiplier value, wherein the number of shares are purchased by a player at the time of entry indicia selection.

Further, claim 48 recites “determining a total prize amount for each entrant achieving a winning outcome in the individual participation wagering game, wherein the total prize amount for each entrant is equal to the entrant’s individual prize amount multiplied by the multiplier value”. See claim 40 above.

Claim 65 recites “the second subset of primary game indicia being selected using a blower-type apparatus adapted for use with balls having primary game indicia disposed thereon”. While a bingo game embodiment is disclosed on P. 35 of applicant’s specification as originally filed, the specific limitations of claim 65 are not.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 3714

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 26 is rejected on the ground of nonstatutory obviousness-type  
double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,425,823**

**B1.** Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 recites all of the limitations of claim 26 of the instant application. Specifically, claim 26 of the instant application recites "forming a group of at least some of the entrants in the individual participation game who have made a wager on a first game and a wager on the outcome of the second group participation game", which does not stipulate that two separate wagers are made. That is, the claim does not disclose placing a wager on a first individual game and placing an additional wager on a second game. Claim 2 recites "means for determining the eligibility of each of said players at each of said gaming machines to receive a portion of said progressive jackpot, each eligible player being certain to receive a portion of said progressive jackpot, each of said eligible players being selected independently of any of said outcomes at said plurality of said gaming machines". Thus, the claims are not patentably distinct.

**Claim 26 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. patent No. 6,336,862 B1.** Although the conflicting claims are not identical, there are not patentable distinct from each other claims claim 1 recites all of the limitations of claim 26 of the instant application.

**Claims 26,67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 5,830,063.** Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. 5,830,063 recites the limitations of claim 26 of the instant application.

Similarly, claim 67 of the instant application is not patentably distinct from claims 1 and 2 of U.S. Patent No. 5,830,063.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3714

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 26-33,36,37,39,66,67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US 4,861,041) in view of Barrie et al. (US 4,837,728).**

Regarding claim 26, Jones discloses a method of playing a group participation wagering game in combination with an individual participation game, the method comprising the steps of forming a group of at least some of the entrant in the individual participation game who have made a wager on a first game and a wager on the outcome of the second group participation game, determining whether the entire group is a winner of the group game, and indicating the outcome of the group game at the conclusion thereof. Specifically, Jones discloses a progressive bonus secondary game that a player may participate in by placing an additional wager (abstract). Further, Jones discloses an embodiment of the invention wherein two players, i.e. a group of at least some of the entrants in the individual participation game who have made a wager on a first game and a wager on the outcome of the second group game, share the progressive jackpot (col. 5, line 65-col. 6, line 6). In this example, the entire group of two players is determined to be a winner. Jones does not specifically disclose that the individual participation game is played on an electronic gaming machine, a plurality of gaming machines being linked to a central processing unit, said central processing unit performing said step of determining whether the entire group is a winner of the group game. However, it is well known in the art at the time of the invention to play the



gambling games disclosed by Jones on an electronic gaming apparatus, as disclosed in Barrie, col. 3, lines 6-7. Barrie teaches of an electronic gaming machine featuring a progressive bonus, wherein the electronic gaming machine may feature a poker game. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Jones with the CPU and display of Barrie in order to automate the poker game disclosed by Jones. One would be motivated to do so in order to reduce the possibility of human error and/or cheating in card games such as poker.

Regarding claim 27, Jones discloses the group forming step includes forming a group of all entrants in the first wagering game who have made a separate wager on the outcome of the second group game, that is, in an example illustrated by Jones in col. 5-6, Players A and B are eligible to win the progressive jackpot because each has placed a separate wager. In this example, the entire group of entrants eligible to win the jackpot, i.e. Players A and B, is formed of all entrants who have made a separate wager.

Regarding claims 28,31-33 Jones discloses the step of determining whether the group is a winner includes randomly generating indicia and comparing at least a portion of the indicia with predetermined indicia that represents a winning combination. Specifically, Jones discloses a poker embodiment wherein generated cards, i.e. indicia, are compared to predetermined winning combinations, e.g. Royal Flush, Straight, etc. in order to determine if the group is a winner.

Regarding claim 29, Jones discloses that the indicia are displayed in the form of an array, i.e. the indicia are arranged in some manner, as five cards are dealt to

Art Unit: 3714

participants to form a "hand", or are displayed to the player as being arranged to form a hand (col. 4, lines 29-35).

Regarding claim 30, Jones discloses the step of indicating the outcome of the game includes displaying each randomly generated indicium one-by-one in the array, Jones discloses the dealer deals the cards, wherein it is well known that cards are dealt one-by-one to each participant (col. 4, lines 29-35).

Regarding claim 36, Jones discloses providing a progressive jackpot component in connection with keno machines (col. 1, lines 17-20).

Regarding claim 37, Jones discloses that the individual participation game is a game of chance, e.g. – poker.

Regarding claim 39, Jones discloses that the individual participation game is a lottery, as the cards dealt to the player are drawn from a plurality of possible cards.

Regarding claims 66,67 and 71, in addition to the features described above, Jones describes an embodiment of the invention wherein a player is involved in a game of Twenty-One. (col. 3, line -col. 4 line 5). In this embodiment, the dealer's hand may act as the determined primary game outcome, wherein the primary game outcome is compared to the entry of each entrant for the primary game. That is, a player must beat the dealer's hand, without the face value of the sum of their cards going over a total of 21, in order to win the primary game. Thus, the primary game outcome, i.e. the dealer's hand, is compared to the entry of each entrant, i.e. each player's hand, in the primary game. Further, the secondary game outcome associated with the primary game exists in the pay-table disclosed by Jones in col. 3, line – col. 4, line 5. Specifically, in the

Art Unit: 3714

Twenty-One game embodiment, various combinations of cards, in addition to having made an additional wager on the secondary game, makes a player eligible to receive the progressive bonus. As described with regard to claim 26 above, Jones contemplates an embodiment of the invention where each entrant that placed a secondary wager on the secondary game associated with the primary game and that is determined to have a winning entry in the primary game may be awarded a secondary game award amount (col. 5, line 65-col. 6, line 6). That is, if the two players who placed a secondary wager obtain a primary game winning outcome, they are both awarded a portion of the jackpot.

***Allowable Subject Matter***

Claims 34, 35, 68 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 70 and 72 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

Claim 34 contains the limitation "each entrant is awarded the same winning prize amount". This limitation is not disclosed in the prior art, as Jones teaches each entrant is awarded a different percentage of the jackpot. Claim 35 depends from claim 34, and is therefore also allowable.

Claim 72 disclose a Keno embodiment of the invention. This is allowable over the prior art as the examiner's interpretation Jones teaches a Twenty-One type gaming method wherein the dealer's hand is used as the primary game outcome, and is then

compared to each of the player's hands in order to determine if the player is a winner. It is not obvious to modify the Twenty-One game of Jones into a Keno embodiment, as this would destroy the dealer's hand interpretation of a primary game outcome. (As claim 36 does not contain this primary game outcome limitation, a keno game embodiment does not destroy the teachings of Jones as applied to claim 36).

Claim 70 contains the limitation of "determining a primary game award amount ... based on the level of correspondence between the first subset of primary game indicia for the entrant and the second subset of primary game indicia for the primary game". This limitation is not met by the Twenty-One interpretation of Jones.

### ***Response to Arguments***

Applicant's arguments with respect to claims 26-37 and 66-72 have been considered but are moot in view of the new ground(s) of rejection. Specifically, applicant's argument that Jones et al., U.S. 4,861,041, is not citable against the claims of the present continuation application in light of Applicant's foreign priority claim, is moot in view of the new grounds of rejection.

Applicant's arguments filed February 21, 2007 have been fully considered but they are not persuasive. Specifically, applicant's argument that the amendments to the claims overcome the 35 U.S.C. 112, first paragraph, written description rejection of claims 40-65 is not persuasive. Please see the above rejection for details.

### ***Conclusion***

Art Unit: 3714

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes:

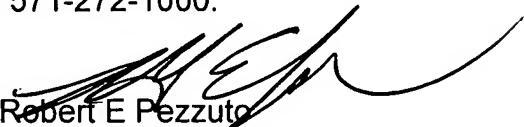
- Jones (U.S. 5,078,405, 5,288,077, and 5,374,067), drawn to a gambling game featuring a progressive jackpot.
- Wilkinson (U.S. 5,129,652), drawn to a casino drawing/lottery game and prize management system.
- Lovell (U.S. 5,273,281), drawn to a game card and associated playing method.
- Weingardt et al. (U.S. 5,275,400), drawn to a pari-mutuel electronic gaming system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert E Pezzuto  
Supervisory Patent Examiner  
Art Unit 3714

Meagan Thomasson  
May 18, 2007